

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Joseph A. Zupanick Art Unit : 3673
Serial No. : 10/630,345 Examiner : John J. Kreck
Filed : July 29, 2003 Conf. No. : 9309
Title : METHOD AND SYSTEM FOR ACCESSING SUBTERRANEAN DEPOSITS
FROM THE SURFACE AND TOOLS THEREFOR

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO REQUIREMENT FOR INFORMATION OF JULY 3, 2007

In reply to the Requirement for Information of July 3, 2007, Applicant and Assignee (collectively hereinafter "Applicant") submit the following remarks. Applicant thanks the Examiner for the in-person interview on September 4, 2007, during which this Requirement for Information and the patentability of the claims and content of the prior art were discussed.

For ease of reference, each section of the following remarks is preceded by the relevant excerpt from the Requirement for Information.

i. Applicant and assignee are required to comment on the Gardes declaration. MPEP 704.11(a)(N)

In response to this requirement, please provide the following.

ii. Any written descriptions or analyses, prepared by any of the inventors or assignees, of services in competition with the goods or services the claimed subject matter has been embodied in. MPEP 704.11(a)(F)

Applicant respectfully requests that this request be withdrawn, because as discussed with the Examiner, it has not been shown that the request is reasonably necessary as set forth in MPEP 704.11. Specifically, it has not been shown that the claimed subject matter cannot be adequately searched by class or keyword among patents and typical sources of non-patent literature or that either the application file or the lack of relevant prior art found in the search justifies asking the Applicant if he or she has information that would be relevant to the

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: January 03, 2008

patentability determination. Moreover, MPEP 704.11 states that a requirement for information under 37 CFR 1.105 is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Applicant respectfully submits that this request is very broad as it requests “*any* written descriptions or analysis, prepared by *any* of the inventors or assignees” in competition with subject matter that is a primary focus of Applicant’s business – drilling wells into coal seams.

iii. Is or was there a license agreement as described in the Gardes declaration?

There was a license agreement between Innovative Drilling Technologies LLC and CDX GAS, LLC, effective August 1, 2001. Pursuant to the license agreement, Innovative Drilling Technologies granted CDX GAS a license to two issued patents listing Robert Gardes as an inventor, know-how relating solely to the patents, and enhancements specifically associated with the patents. The terms of the license agreement are confidential, and Applicant cannot disclose such without permission from and/or notice to Innovative Drilling Technologies. However, Applicant notes that the patents were disclosed in an Information Disclosure Statement in connection with the instant application and indicated as considered by the Examiner. If the Examiner desires a copy of the license agreement or Applicant to identify the two licensed patents, Applicant will provide notice to and seek the permission of Innovative Drilling Technologies to provide such.

iv. If yes to (iii): Does that license agreement represent any public use or sale of any of the process steps claimed in the instant application?

This request calls for a legal conclusion, rather a statement of fact, and Applicant submits that such legal conclusion is the domain of the Patent Office in this context. Applicant notes, however, that the subject license agreement was effective August 1, 2001, and that the present application claims priority to patents that pre-date this license by substantially more than one year, including U.S. Patent No. 6,280,000, filed November 20, 1998, and U.S. Patent No. 6,537,523, filed November, 19, 1999. Moreover, as noted above, the patents that were the

subject of the license were disclosed in an Information Disclosure Statement in connection with the instant application and indicated as considered by the Examiner.

v. If yes to (iv): What is the date of such public use or sale?

Applicant refers to its response above.

A Petition for Four-Month Extension of Time, along with all required fees in the amount of \$1640 are being filed and paid simultaneously with this Reply via the Electronic Filing System (EFS) by way of Deposit Account No. 06-1050. No additional fees are believed due. However, the Commissioner is hereby authorized to charge any deficiencies or other required fees or any credits to deposit account 06-1050, referencing the attorney docket number shown above.

Respectfully submitted,

Date: January 3, 2008

/Joshua A. Griswold/
Joshua A. Griswold
Reg. No. 46,310

Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022
Telephone: (214) 292-4034
Facsimile: (214) 747-2091